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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,154	01/25/2002	Kurt Gross	GR 01 P 0922	2489

7590

03/10/2003

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT

PAPER NUMBER

2826

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/057,154

Applicant(s)

GROSS ET AL.

Examiner

Alexander O Williams

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2826

Serial Number: 10/057154 Attorney's Docket #: GR01P0922  
Filing Date: 1/25/02; claimed foreign priority to 1/25/01

Applicant: Gross et al.

Examiner: Alexander Williams

Applicant's Amendment in Paper # 8, filed 11/27/02 has been acknowledged.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for drawing, does not reasonably provide enablement for specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to show the invention commensurate in scope with these claims. The ceramic plate labeled "K" in the figure, should be described in the specification.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 to 7, **insofar as claim 7 can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bareither et al. (U.S. Patent # 5,731,635).

Initially, it is noted that the 35 U.S.C. § 103 rejection based on the buffer layers, connection medium and a metallization layer deals with an issue (i.e., the integration of multiple pieces into one piece or conversely, using multiple pieces in replacing a single piece) that has been previously decided by the courts.

In Howard v. Detroit Stove Works 150 U.S. 164 (1893), the Court held, "it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together...."

In In re Larson 144 USPQ 347 (CCPA 1965), the term "integral" did not define over a multi-piece structure secured as a single unit. More importantly, the court went further and stated, "we are inclined to agree with the solicitor that the use of a one-piece construction instead of the [multi-piece] structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice" (bracketed material added). The court cited In re Fridolph for support.

In re Fridolph 135 USPQ 319 (CCPA 1962) deals with submitted affidavits relating to this issue. The underlying issue in In re Fridolph was related to the end result of making a multi-piece structure into a one-piece structure. Generally, favorable patentable weight was accorded if the one-piece

structure yielded results not expected from the modification of the two-piece structure into a single piece structure.

For example, in claim 1, Bareither et al. **(the figure)** show a carrier and a chip configuration, comprising: a carrier **4** having a metal area essentially composed of copper; a chip **1** having a rear side metallization layer **21**; a buffer layer **3,21-24** configured on said metal area, said buffer layer being essentially composed of nickel **23** and having a thickness between 5 to 10 micrometers; and a connection medium **21-24** for fixedly connecting said chip to said carrier **(see column 3, lines 40-45)**; said chip being configured, without a chip housing, on said metal area such that only said connecting medium is configured between said rear side metallization layer of said chip and said buffer layer.

In claim 2, Bareither et al.'s buffer layer has a thickness between 7 to 9 micrometers.

In claims 3 and 4, Bareither et al.'s rear side metallization layer **21** is essentially composed of aluminum.

In claim 5, Bareither et al.'s buffer layer has a surface facing said chip, and said surface facing said chip includes a protective layer that is essentially composed of gold **(see column 2, lines 7-18)**.

In claim 6, Bareither et al.'s carrier is essentially composed of gold **(see column 1, lines 46-58)**.

In claim 7, Bareither et al.'s carrier **4** includes includes a plate made of ceramic, said metal area is applied on said plate, and said chip has a contact area formed by said metal area.

Therefore, it would have been obvious to one of ordinary skill in the art to use the buffer layers, connection medium and a metallization layer as "merely a matter of obvious engineering choice" as set forth in the above case law.

Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

## Response

Applicant's arguments filed 11/27/02 have been fully considered, but are not found to be persuasive.

Applicant arguments on pages 3-8 have been considered, but are not persuasive.

Applicant's statement that "The Bareither et al reference discloses a semiconductor device where a semiconductor chip is fastened to a carrier and provided with electrical connection lines and incorporated in a package (column 1, lines 17-23)" is not found to be persuasive. This was stated in the "Background of the Invention" section of the patent reference to prior art of Bareither et al. invention. Bareither et al.'s Summary of the Invention" section states that "A semiconductor device comprising a carrier, at least one semiconductor component provided thereon, and a multilayer metallization between the semiconductor component and the carrier" is used in the invention. (see column 2, lines 7-11) A package is not discussed or shown in the invention.

Applicant's statement stating "Furthermore, the present invention discloses an uncommonly thick buffer layer having a thickness between 5 micro meters to 10 micro meters, which is applied to the carrier. In the Bareither et al. reference however, a nickel layer of .2 micro meter to .3 micro meter is applied on the semiconductor component" is not found to be persuasive. Bareither et al. disclose a buffer layer made of a multilayer structure with a combined thickness greater than 5 micron. This structure is shown in the third layer of the multiple layer structure having a layer essential of nickel with a thickness from 0.05 to 0.5 micro meters. This structure also show a forth layer of the multilayer layer structure having a layer of gold with a thickness form 0.5 to 5 micro meters. This combination of these two layer in the multilayer structure representing the buffer layer has a thickness that can be at least 5.5 micro meters. (See column 2, lines 7-45) Applicant claims the buffer layer having a thickness between 5 to 10 micrometers. This is shown in Bareither et al.'s multilayer structure of the buffer layer.

Given the teaching of the references, it would have been obvious to determine the optimum thickness, temperature as well as condition of delivery of the layers involved. See *In re Aller, Lacey and Hall* (10 USPQ 233-237) "It is not inventive to discover optimum or workable ranges by routine experimentation. Note that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 f.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)."

Any differences in the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

Appellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness. *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

An Affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2826

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Field of Search	Date
U.S. Class and subclass: 257/703,700,701,702,676,765,763,766,769,758,771- 773,762 156/278	8/26/02 3/7/03
Foreign Documentation: foreign patents and literature in 257/703,700,701,702,676,765,763,766,769,758,771- 773,762 156/278	8/26/02 3/7/03
Electronic data base(s): U.S. Patents EAST	8/26/02 3/7/03

***Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.***

Any inquiry concerning this communication or any earlier communication from the examiner should be directed to ***Examiner Alexander Williams*** whose telephone number is ***(703) 308-4863***.



Art Unit: 2826

Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center 2800 receptionist** whose telephone number is **(703) 308-0956**.

3/7/03

A handwritten signature in black ink, appearing to read 'A. O. Williams', with a stylized flourish at the end.

Primary Examiner  
Alexander O. Williams